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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,073	10/21/2003	Tokihiro Shimura	4230-101	6700

23448 7590 02/03/2006

INTELLECTUAL PROPERTY / TECHNOLOGY LAW  
PO BOX 14329  
RESEARCH TRIANGLE PARK, NC 27709

EXAMINER

MARCHESCHI, MICHAEL A

ART UNIT PAPER NUMBER

1755

DATE MAILED: 02/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

12

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/690,073

Applicant(s)

SHIMURA, TOKIHIRO

Examiner

Michael A. Marcheschi

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**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 11 January 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☒ Applicant's reply has overcome the following rejection(s): new matter rejections based on anhydrous silica and pressurized.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1-11, 23 and 24.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

Michael A. Marcheschi  
Primary Examiner  
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**ATTACHMENT TO ADVISORY****ARGUMENTS WITH RESPECT TO THE NEW MATTER REJECTIONS:**

With respect to the rejections of claims 1-11 and 23-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement, applicants argue this rejection in terms of scope of enablement, however, this rejection is based on a rejection of new matter added to the claims, when amended. This is evident from the statement “the **new matter** added to claims...”. Applicants have not clearly shown where support can be explicitly or reasonably found for the added limitations. To support the arguments, applicants state that the claims are to be given the broadest reasonable interpretation that is consistent with the specification. The examiner is well aware of this and that limitations and the examples in the specification do not generally limit what is covered by the claimed, however, absent of a range in the claims would have one to look for the specification for guidance. In every instance that teaches aluminum, boron and titanium in the specification said teachings are associated with an amount, thus how does this provide reasonable support for any and all amounts of these components. In view of this, the claims are **inconsistent** with the teachings of the specification. The legal authority to limit the amounts of aluminum, boron and titanium is that the specification only defines these components in specific amounts (the specification never broadly defines these components absent amounts). It is clear that any amendments added must be clearly supported by the specification and the examiner is unclear as to how specific amount provides the necessary support for any and all amount of aluminum, boron and titanium. Any added subject matter during prosecution must be clearly supported by the specification, as filed. With respect to the proviso situation, applicants argue that the examiner is attempting to limit the claims to the

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specific examples. The examiner is not doing this, to the contrary, the examiner held this as new matter because the specification never defines this proviso in a single passage or example. The only place that the proviso might be supported is in the examples. Looking to the examples for support, the only example that defines “titanium in the absence of aluminum and boron” is example 5 (which is a comparative example). This example clearly established that the amount of Si is only 0.8 %. Since the specification, as filed, does not clearly establish the claimed proviso, it is new matter. Applicants apparently state that the examiner has conjured the reasoning out of thin air. To the contrary, it is well established that any added subject matter to the claims must be clearly supported by the specification, as originally filed. The examiner cannot find any instance in the specification that clearly defines the added subject matter, in it broad sense. Applicants continue to state that the examiner is limiting the claims to the specific examples. As defined above, the examiner is not limiting the claims but rather defining that no support in the original specification can be found for the added subject matter. Since applicants have not shown where clear support can be found, no further comment is deemed necessary.

With respect to the new matter based on the “anhydrous silica” and the “pressurized”, the examiner withdraws these rejections.

#### **ARGUMENTS WITH RESPECT TO THE ART REJECTIONS:**

All of the art rejections were defined in the last office action.

With respect to the sustained rejection of claims 1-8, 11 and 23-24 as rejected under 35 U.S.C. 103(a) as obvious over Bergkvist in view of Achikita et al. applicants argue that the primary reference does not teach the claimed proviso. The examiner acknowledges this but has

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stated in the previous office action that “applicants are arguing the amended limitations which define new matter as set forth above and thus since said limitations are new matter, the above rejection is upheld in view of the new matter to the claims”. However, upon clear evidence as to why the above limitations are not new matter, the examiner will withdraw this rejection. To comment on the specifics of the arguments, applicants do not argue the examiners reasons for combining but rather appear to be arguing the references individually and one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The examiner has only applied the secondary reference as evidence that shows the size of a powder. Applicants have not argued this point but rather argue the organic boron of the secondary reference. The examiner is aware of this, but this reference is only applied for the teaching of the size of a powder. With respect to all of the other characteristics, as previous defined, since the powder is the same the characteristics are expected and applicants have not shown otherwise.

With respect to the sustained rejection of claims 1-8, 11 and 23-24 as rejected under 35 U.S.C. 103(a) as obvious over DE 19815087 in view of Tanaka et al., applicants argue that the primary reference does not teach the claimed proviso. The examiner acknowledges this but has stated in the previous office action that “applicants are arguing the amended limitations which define new matter as set forth above and thus since said limitations are new matter the above rejection is upheld in view of the new matter to the claims”. However, upon clear evidence as to why the above limitations are not new matter, the examiner will withdraw this rejection.

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To comment on the specifics of the arguments, applicants do not argue the examiners reasons for combining but rather appear to be arguing the references individually and one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The examiner has only applied the secondary reference as evidence that shows the size of a blasting medium, which applicants have not argued. With respect to all of the other characteristics, as previous defined, since the powder is the same the characteristics are expected and applicants have not shown otherwise.

With respect to the sustained rejection of claims 1-11 and 23-24 are rejected under 35 U.S.C. 103(a) as obvious over JP 2002-256255 in view of Bergkvist, applicants argue that the primary reference does not teach the claimed proviso. The examiner acknowledges this but has stated in the previous office action that “applicants are arguing the amended limitations which define new matter as set forth above and thus since said limitations are new matter the **above rejection is upheld in view of the new matter to the claims**”. However, upon clear evidence as to why the above limitations are not new matter, the examiner will **withdraw** this rejection. To comment on the specifics of the arguments, applicants does not argue the examiners reasons for combining but rather appear to be arguing the references individually and one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The examiner only applied the secondary reference as evidence that shows that stainless steels generally comprise chromium in the claimed amount, which applicants have not argued. With respect to all of the other

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characteristics, as previous defined since the powder is the same the characteristics are expected and applicants have not shown otherwise.

With respect to the sustained rejection of claims 1-11 and 23-24 as rejected under 35 U.S.C. 103(a) as obvious over JP 2001-009727 in view of Magnusson et al. and Bergkvist, applicants argue that the primary reference does not teach the claimed proviso. The examiner acknowledges this but has stated in the previous office action that “applicants are arguing the amended limitations which define new matter as set forth above and thus since said limitations are new matter the **above rejection is upheld in view of the new matter to the claims**”.

However, upon clear evidence as to why the above limitations are not new matter, the examiner will **withdraw** this rejection. To comment on the specifics of the arguments, applicants argue that Magnusson et al. is directed to a connector structure, thus it is non analogous art and therefore the references can not be combined. The examiner acknowledges that the secondary reference is not directed to applicants filed of endeavor, however, the examiner only applied the secondary reference as evidence that shows that stainless steels are known to have a hardness within the primary reference range (range determined by calculation set forth in the first office action), which applicants have not argued. This secondary reference is only applied as an evidence teaching that stainless steel has a Mohs hardness of 5.7 and not for any other teachings. Although the reference is non analogous, the primary reference implies that any material having a hardness between 3 and 6 can be used (see first action) and one skilled in the art would have appreciated that stainless steels falls within the is category (has this hardness), as evidenced by Magnusson, and thus is applicable in the primary reference. With respect to Bergkvist, the examiner only applied this secondary reference as evidence that shows that stainless steels

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generally comprise chromium in the claimed amount, which applicants have not argued. With respect to all of the other characteristics, as previously defined since the powder is the same the characteristics are expected and applicants have not shown otherwise.

With respect to the sustained rejection of claims 1-8, 11 and 23-24 are rejected under 35 U.S.C. 103(a) as obvious over either (1) JP 2002-114968 or (2) JP 2001-122644 **both** in view of Bergkvist, applicants argue that the primary references do not teach the claimed proviso. The examiner acknowledges this but has stated in the previous office action that “applicants are arguing the amended limitations which define new matter as set forth above and thus since said limitations are new matter the **above rejection is upheld in view of the new matter to the claims**”. However, upon clear evidence as to why the above limitations are not new matter, the examiner will **withdraw** this rejection. To comment on the specifics of the arguments, applicants does not argue the examiners reasons for combining but rather appear to be arguing the references individually and one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The examiner only applied the secondary reference as evidence that shows that stainless steels generally comprise chromium in the claimed amount, which applicants have not argued. With respect to all of the other characteristics, as previously defined since the powder is the same the characteristics are expected and applicants have not shown otherwise.

With respect to the sustained rejection of claims 9-10 are rejected under 35 U.S.C. 103(a) as obvious over DE 19815087 in view of Tanaka et al., as applied to claim 1 above and further in view of either (1) JP 2002-256255, (2) JP 2001-009727 or (3) Kydd, applicants argue that the



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primary reference do not teach the claimed proviso. The examiner acknowledges this but has stated in the previous office action that “applicants are arguing the amended limitations which define new matter as set forth above and thus since said limitations are new matter the **above rejection is upheld in view of the new matter to the claims**”. However, upon clear evidence as to why the above limitations are not new matter, the examiner will **withdraw** this rejection. To comment on the specifics of the arguments, applicants do not argue the examiners reasons for combining but rather appear to be arguing the references individually and one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The examiner has applied the secondary references as evidence that show surface treating abrasives (stainless steels) with the claimed material improves the performance of the abrasive, which applicants have not argued. The only argument based on Kydd is that the compositions are not in any way disclosive or suggestive of the claimed invention. The examiner is aware of this and has not applied this reference for this teaching but rather the teaching of treating steels with stearic acid, which has not been argued. With respect to all of the other characteristics, as previous defined since the powder is the same the characteristics are expected and applicants have not shown otherwise.

With respect to the sustained rejection of claims 9-10 are rejected under 35 U.S.C. 103(a) as obvious over either (1) JP 2002-114968 or (2) JP 2001-122644 **both** in view of Bergkvist, as applied to claim 1 above and further in view of either (1) JP 2002-256255, (2) JP 2001-009727 or (3) Kydd, applicants argue that the primary reference do not teach the claimed proviso. The examiner acknowledges this but has stated in the previous office action that “applicants are

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arguing the amended limitations which define new matter as set forth above and thus since said limitations are new matter the **above rejection is upheld in view of the new matter to the claims**". However, upon clear evidence as to why the above limitations are not new matter, the examiner will **withdraw** this rejection. To comment on the specifics of the arguments, applicants do not argue the examiners reasons for combining but rather appear to be arguing the references individually and one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The examiner has applied the secondary references as evidence that show surface treating abrasives (stainless steels) with the claimed material improves the performance of the abrasive, which applicants have not argued. The only argument based on Kydd is that the compositions are not in any way disclosive or suggestive of the claimed invention. The examiner is aware of this and has not applied this reference for this teaching but rather the teaching of treating steels with stearic acid, which has not been argued. With respect to all of the other characteristics, as previous defined since the powder is the same the characteristics are expected and applicants have not shown otherwise.

**As defined above, upon clear evidence as to why the added limitations are not new matter, the examiner will withdraw all of the above art rejection.**

With respect to the new rejection of claims 1-8, 11 and 23-24 are rejected under 35 U.S.C. 103(a) as obvious over Bergkvist in view of Sridhar et al. and Achikita et al., applicants argue that the primary reference does not teach the claimed proviso. The examiner

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acknowledges this but has stated in the previous office action that Bergkvist states that impurities can be present in the stainless steel and since aluminum is a impurity in stainless steels, as shown by Sridhar et al., this component is obvious in the steel according to Bergkvist. The motivation is that Bergkvist teaches that impurities can be present. With this being obvious (i.e. aluminum in the steel according to Bergkvist), the claimed invention is met since the claimed invention can include aluminum (line 3 of claim 1) and the proviso limitation is a proviso assuming no aluminum is present, thus said proviso does not have to be a definite claimed limitation. In other words, since Bergkvist suggests that aluminum is present (thus teaching stainless steel that contains titanium and aluminum), the claimed proviso does not exclude this reference because it is a proviso based on the absence of aluminum. Applicants arguments based on Sridhar et al. are directed to the reference teachings alone and no arguments are presented that rebut the examiners reliance of this reference. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The examiner has only applied Sridhar et al. as evidence that shows that aluminum is an impurity in stainless steels. Applicants have not argued this point but rather this reference alone and not in the combination as defined. Applicants argue that Sridhar et al. is non analogous art and therefore the references can not be combined. The examiner acknowledges that the secondary reference is not directed applicants filed of endeavor, however, the examiner only applied the secondary reference as evidence that shows that impurities in stainless steels are known to include aluminum. Since Bergkvist teaches that impurities can be present, one skilled in the art would clearly known what this encompasses (what the impurities are), as evidence by

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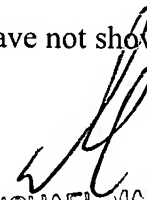
this secondary reference. In other words, although this secondary reference is non analogous, the primary reference implies that any known impurity is present and one skilled in the art would have appreciated that stainless steels impurities include aluminum, as evidenced by the secondary reference. If applicants contend that aluminum is not an impurity in stainless steel, they are requested to make this of records. With respect to Achikita et al., the examiner has only applied the secondary reference as evidence that shows the size of a powder. Applicants have not argued this point but rather argue the organic boron of the secondary reference. The examiner is aware of this, but this reference is only applied for the teaching of the size of a powder. In summary, applicants arguments are directed to individual references and not the references, as combined, and this type of argument is improper. Even if combined, applicants argue that the references do not teach all of the claimed characteristics. The examiner is aware of this and has made a statement in the previous office action that "all of the examiners reasoning for the claimed invention being taught by Bergkvist in view of Achikita et al. are defined in the previous office action and are incorporated herein by reference". In the rejection referred to above, although all of the claimed characteristics are not literally defined, since the powder is the same the characteristics are expected and applicants have not shown otherwise.

With respect to the new rejection of claims 9-10 are rejected under 35 U.S.C. 103(a) as obvious over Bergkvist in view of Sridhar et al. and Achikita et al. as applied to claim 1 above and further in view of DE 19815087 and at least one of (1) JP 2002-256255, (2) JP 2001-009727 or (3) Kydd, applicants argue that the primary reference do not teach the claimed proviso. The examiner acknowledges this but has stated in the previous office action that Bergkvist states that impurities can be present in the stainless steel and since aluminum is a impurity, it is within the

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scope of the reference (see rejection immediately above). To comment on the specifics of the arguments, applicants do not argue the examiners reasons for combining but rather appear to be arguing the references individually and one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The examiner has applied the secondary references as evidence that show surface treating abrasives (stainless steels) with the claimed material improves the performance of the abrasive, which applicants have not argued. The only argument based on Kydd is that the compositions are not in any way disclosive or suggestive of the claimed invention. The examiner is aware of this and has not applied this reference for this teaching but rather the teaching of treating steels with stearic acid, which has not been argued. With respect to all of the other characteristics, as previous defined since the powder is the same the characteristics are expected and applicants have not shown otherwise.

With respect to all of the art rejections above, applicants appear to argue that the specification provides evidence of criticality for the claimed ranges. A mere statement in the specification for these results is insufficient to establish critically. Finally, applicants have not provided evidence rebutting the examiners statement based on the characteristics (i.e. since the powder is the same the characteristics are expected and applicants have not shown otherwise).



MICHAEL MARCHESCHI  
PATENT ATTORNEY